

**REMARKS**

Claims 1-13 were pending and stand rejected. Claims 1-13 have been amended to clarify, more particularly point out, and more distinctly claim inventive concepts previously present in these claims. Claims 14-29 have been added. Therefore, Claims 1-29 are currently pending. Certain amendments do not narrow the scope of the claims, and certain amendments are not required for patentability. Applicant respectfully submits that no new matter has been added by the amendments to the specification or by the amendments to the claims. In order to advance prosecution of this Application, Applicant has responded to each notation by the Examiner. Applicant respectfully requests reconsideration and favorable action in this case.

**Claim 8**

Applicant makes note that although the cover sheet of the pending Office Action indicates that Claim 8 stands rejected, the body of the Office Action does not indicate a rejection of Claim 8. Applicant would appreciate clarification.

**Amendment to the Specification**

Applicant has amended the Specification. These amendments should not be interpreted so as to limit the scope of Applicant's disclosure or claims.

**Section 102 Rejections**

Claims 1, 4-5, and 9-13 stand rejected under 35 U.S.C. § 102(e) as allegedly being unpatentable over U.S. Patent 6,712,701 to Boylan, III, et al. ("*Boylan*"). Applicant respectfully traverses these rejections for the reasons discussed below. Accordingly, Applicant respectfully requests reconsideration and allowance of Claims 1, 4-5, and 9-13.

**a. Claim 1 is patentable over *Boylan***

Applicant respectfully submits that *Boylan* fails to disclose, or even teach or suggest, the combination of elements specifically recited in Applicant's Claim 1, as amended. For example, amended Claim 1 recites, in part, "allowing a player to choose a plurality of the event's races to be included in the wager, the number of chosen races corresponding to the predetermined quantity."

The Examiner stated that *Boylan* discloses a system which “lead[s] a wagerer through the process of selecting a number of events to be included in their wager (ie: several different racetracks or different racing sports)(see FIG. 6 and the related description thereof, col. 5: ln 6-26).” See Office Action, page 2, paragraph 4. *Boylan* discloses a

“[t]ransaction processing and subscription management system 24 may contain computer equipment 26 and other equipment for supporting system functions such as transaction processing (e.g., handling tasks related to wagers, product purchasing, adjusting the amount of funds in user accounts based on the outcomes of wagers, video clip ordering, etc.), data distribution (e.g., for distributing racing data to the users), and subscriber management (e.g., features related to opening an account for a users, closing an account, allowing a user to add or withdraw funds from an account, changing the user’s address or personal identification number, etc.). Databases within transaction processing and subscription management system 24 or associated with system 24 may be used to store racing data, wagering data and other transaction data, and subscriber data such as such as information on the user’s current account balance, past wagering history, individual wager limits, personal identification number, billing addresses, credit card numbers, bank account numbers, social security numbers, etc. Using such databases may allow the user to access information more quickly and allow for central administration of the wagering service.”

See *Boylan*, column 5, lines 6-26. No where in this excerpt from *Boylan* is there a reference relevant to selecting a number of events or races to be included in a wager.

*Boylan* fails to disclose, teach or suggest “allowing a player to choose a plurality of the event's races to be included in the wager, the number of chosen races corresponding to the predetermined quantity,” of amended Claim 1. *Boylan* discloses an interactive wagering system which provides for electronic racing forms and electronic books. *Id.* at column 1, lines 31-33. *Boylan* does not discloses a method of wagering in which a player is allowed to “choose a plurality of the event's races to be included in the wager, the number of chosen races corresponding to the predetermined quantity” of events races which are included in a wager. Claim 1, as amended. At most, *Boylan*’s system allows a user to select different races and to bet on those different races using the interactive system. See *Boylan* at column 18, lines 4-14. *Boylan*’s system could be used, for example, to pick a winner in several races within a horse racing event or to make typical bets such as exactas and trifectas in those races. *Id.* While the user can select the races in which the user wishes to participate, there is no disclosure in *Boylan* of a predetermined quantity of races being established to be included

in a wager and a user choosing a plurality of races within an event, the number of chosen races corresponding to the predetermined quantity. In the recited invention, for example, the predetermined quantity might be five. In which case, the player would then pick five races from among the event's races. The player's selected winners in those five races would then form the wager. There is no such disclosure in *Boylan*. Thus, *Boylan* fails to disclose, teach or suggest "allowing a player to choose a plurality of the event's races to be included in the wager, the number of chosen races corresponding to the predetermined quantity," of amended Claim 1.

As a result, *Boylan* fails to recite, either explicitly or inherently, the combination of elements specifically recited in amended Claim 1. Amended Claim 1 is thus allowable for at least this reason.

**b. Claim 9 is patentable over *Boylan***

Applicant respectfully submits that *Boylan* fails to disclose, or even teach or suggest the combination of elements specifically recited in Applicant's Claim 9, as amended. For example, amended Claim 9 recites, in part, "establishing a predetermining quantity of the event races to be included in the wager." Amended Claim 9 further recites "receiving a first selection of a subset of the plurality of races within the racing event from each of the plurality of players, the number of races in the first selection corresponding to the predetermined quantity in the wager."

*Boylan* fails to disclose, teach, or suggest such combination of elements. For reasons similar to those stated in the previous section, there is no disclosure in *Boylan* of a predetermined quantity of races to be included in a wager being established and each player selecting a subset of the plurality of races within the racing event, the number of races in the first selection corresponding to the predetermined quantity in the wager. Accordingly, for at least similar reasons, Claim 9 is allowable.

**c. Claims 4-5 and 10-13 are patentable over *Boylan***

Applicant's dependent Claims 4-5 and 10-13 are allowable based on their dependence on independent Claims 1 and 9 and further because they recite numerous additional patentable distinctions over the reference of the rejection. Because Applicant believes they have amply demonstrated the allowability of independent Claims 1 and 9 over *Boylan*, and to avoid burdening the record, Applicant has not provided additional detailed remarks

concerning these dependent claims. Applicant, however, remains ready to provide such remarks if it becomes appropriate to do so.

### **Section 103 Rejections**

Claims 2-3 and 6-7 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Boylan* in light of U.S. Patent 5,830,068 to Brenner, et al. ("*Brenner*"). Applicant respectfully traverses these rejections for the reasons discussed below. Accordingly, Applicant respectfully requests reconsideration and allowance of Claims 2-3 and 6-7.

#### **a. The *Boylan-Brenner* combination fails to teach or suggest the combination of elements specifically recited in amended Claims 2-3**

Applicant respectfully submits that the combination of *Boylan* and *Brenner* proposed by the Examiner fails to disclose, teach, or suggest the combination of elements specifically recited in Applicant's Claims 2-3, as amended.

The Examiner relies on column 12, line 9-26 of *Brenner* states that "in its system a user may place additional wagers but is limited by the state of the queue to five wagers per form." Office Action, page 4, paragraph 3. The Examiner proposes that "it would be obvious to one of ordinary skill in the art at the time of the invention to modify *Boylan* to incorporate this physical limitation into its analogous wagering system, wherein the number selected for the quantity of the event's races to be included in the game is less than the number of races in the event and the number is five." *Id.*

Applicant respectfully submits that the limitations in the wager queue disclosed in *Brenner* fail to provide such teaching. *Brenner* discloses limiting the number of wagers in a wager queue where "typically, the wager queue can contain up to five wagers." See *Brenner*, column 12, lines 9-26. *Id.* at column 12, line 17 (emphasis added). Once the queue is full, the wagers must be sent to the racetrack and the user may place new wagers in the queue. *Id.* at column 12, lines 18-19; *Id.* at Figure 3. Thus, ***Brenner* discloses a system that limits the number of wagers included in one queue, not the number of event races included in one wager.** *Id.* (emphasis added). Moreover, there is no disclosure in *Brenner* which discusses further limiting the number of event races included in a wager to less than a total number or

races in the event. Accordingly, *Brenner* fails to disclose, teach, or suggest the combination of elements recited in amended Claim 2.

As discussed above, *Boylan* fails to disclose, teach, or suggest, “allowing a player to choose a plurality of the event's races to be included in the wager, the number of chosen races corresponding to the predetermined quantity,” of amended Claim 1. For at least similar reasons, *Boylan* fails to disclose, teach, or suggest this element specifically recited in amended Claim 1 and in its dependent Claims 2-3.

As a result, the *Boylan-Brenner* combination fails to recite the combination of elements specifically recited in amended Claims 2-3. Amended Claims 2-3 are thus allowable for at least these reasons.

**b. The *Boylan-Brenner* combination fails to teach or suggest the combination of elements specifically recited in amended Claim 6-7**

Applicant respectfully submits that the combination of *Boylan* and *Brenner* proposed by the Examiner fails to disclose, teach, or suggest the combination of elements specifically recited in Applicant's Claims 6-7, as amended. For example, Claim 6 recites, in part “selecting the event races to be included in the wager, the number of selected races corresponding to the predetermined quantity.”

*Boylan* discloses an interactive wagering system which provides for electronic racing forms and electronic books. See *Boylan*, column 1, lines 31-33. *Boylan* does not disclose a method of wagering including the step of “selecting the event races to be included in the wager, the number of selected races corresponding to the predetermined quantity,” of amended Claim 6. As discussed above, at most, *Boylan's* system allows a user to select different races and to bet on those different races using the interactive system. *Id.* at column 18, lines 4-14. While the user can select races in which the user wishes to participate, there is no disclosure in *Boylan* of establishing a predetermined quantity of races and selecting event races to be included in the wager, the number of races corresponding to the predetermined quantity. Thus, *Boylan* fails to disclose, teach or suggest “selecting the event races to be included in the wager, the number of selected races corresponding to the predetermined quantity,” of amended Claim 6.

As discussed above, *Brenner* discloses a system that limits the number of wagers included in one queue, not the number of event races included in one wager. See *Brenner* at

column 12, lines 18-19; *Id.* at Figure 3. Thus, *Brenner* does not disclose, teach, or suggest “selecting the event races to be included in the wager, the number of selected races corresponding to the predetermined quantity,” of amended Claim 6.

Applicant’s dependent Claim 7 is allowable based on its dependence on independent Claim 6 and further because they recite numerous additional patentable distinctions over the reference of the rejection. Because Applicant believes they have amply demonstrated the allowability of independent Claims 6 over the *Boylan-Brenner* combination, and to avoid burdening the record, Applicant has not provided additional detailed remarks concerning these dependent claims. Applicant, however, remains ready to provide such remarks if it becomes appropriate to do so.

Amended Claims 6-7 are thus allowable for at least these reasons.

#### **New Claims**

New Claims 14-29 have been added and are fully supported by the original specification. No new matter has been added.

**CONCLUSION**

For at least the foregoing reasons, Applicant respectfully requests full allowance of all the pending claims.

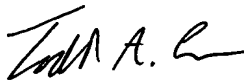
If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Jay Johnson, the Attorney for Applicant, at the Examiner's convenience at (214) 953-6431.

A check in the amount of \$1250.00 is enclosed to cover the cost of the additional claims. The Commissioner is hereby authorized to charge any extra fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Early and favorable acceptance of this Application is respectfully requested.

Respectfully submitted,

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